

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 12 and 19 have been canceled without prejudice or disclaimer. New independent claim 23 has been added. Support for such new claim can be found in the instant specification at least at page 2, lines 11-21, taken in connection with page 6, lines 1-29. Claims 13-16 and 20-22 have been amended to depend from new claim 23, in view of the cancellation of claim 12. Newly added dependent claims 24 and 25 are directed to additional aspects of a method for stimulating an oilfield. Claim 16 has been amended to delete the phrase "preferably 4-acetoxy-styrene", and new claim 26 is directed to such deleted subject matter.

In the Official Action, claims 12-22 stand objected to for the reasons set forth at page 2 of the Official Action. Specifically, the Examiner has objected to the grammar of claim 12. Without addressing the propriety of this objection, it is noted that such objection is moot in view of the above cancellation of claim 12 and addition of independent claim 13. Accordingly, withdrawal of the objection is respectfully requested.

Claims 15-18 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at pages 2-3 of the Official Action. This rejection is moot in view of the above amendments, in which the objected-to term " CellTracker Blue CMAC" has been replaced with the chemical formula 7-amino-4-chloromethylcoumarin. Accordingly, withdrawal of the §112, second paragraph, rejection is respectfully requested.

Claims 12-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,741,400 (*Underdown*). As noted above, claim 12 has been canceled, new independent claim 23 has been added, and the remaining dependent claims directly or indirectly depend from claim 23. Applicants submit that claim 23 is not anticipated by *Underdown* for at least the following reasons.

Independent claim 23 is directed to a method for stimulating an oilfield, comprising the steps of:

a) injecting at least two inflow fluid streams into at least two production zones of an oil producing well linked to the oilfield, or into at least two oil producing wells, wherein at least two scale inhibitors having detectable moieties are introduced into the at least two zones or wells, respectively, wherein each of the at least two scale inhibitors corresponds to a different zone or well,

wherein at least two outflow streams from the at least two zones or wells are combined before recovering,

wherein the at least two scale inhibitors are different from each other, said at least two scale inhibitors comprising different detectable moieties that can be distinguished by analysis;

b) displacing the oil;

c) recovering an outflow stream of fluid comprising the oil and amounts of the at least two scale inhibitors; and

d) measuring the amounts of the at least two scale inhibitors in the recovered outflow stream of fluid, or of a fluid derived therefrom.

Underdown relates to the inhibition of scale formation utilizing one or more scale inhibiting components. See col. 1, lines 5-9. *Underdown* discloses injecting at least one scale inhibitor into a formation through a well so that the scale inhibitor is thereafter

slowly released from the formation to inhibit the formation of scale, and injecting at least one polymeric material into the well in an amount effective to prolong the scale formation inhibition, the polymeric material having a composition different from the scale inhibitor and being a copolymer derived from at least one first monomer having a maleic moiety and at least one second monomer selected from the group consisting of acrylic acid, methacrylic acid and mixtures thereof. See col. 2, line 67 to col. 3, line 11.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For an anticipation to exist, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, *Underdown* does not disclose each feature recited in independent claim 13, and as such fails to constitute an anticipation of such claim. For example, *Underdown* does not disclose injecting at least two inflow fluid streams into at least two production zones of an oil producing well linked to the oilfield, or into at least two oil producing wells, wherein at least two scale inhibitors having detectable moieties are introduced into the at least two zones or wells, respectively, **wherein each of the at least two scale inhibitors corresponds to a different zone or well, wherein the at least two scale inhibitors are different from each other, said at least two scale inhibitors comprising different detectable moieties that can be distinguished by analysis**, as recited in claim 23.

By comparison, *Underdown* is concerned with employing a polymeric material for prolonging scale formation inhibition, which has a composition that is different from the scale inhibitor. *Underdown* is completely silent on providing at least two scale inhibitors

which each **correspond to a different zone or well**. Nor is there any disclosure that such at least two scale inhibitors are different from each other, and comprise different detectable moieties that can be distinguished by analysis. And certainly, *Underdown* fails to disclose measuring the amounts of the at least two scale inhibitors in the recovered outflow stream of fluid, or of a fluid derived therefrom, as recited in claim 23.

As discussed at pages 1-2 of the instant specification, for example, in conventional oilfield systems, the fluids obtained from several individual wells are combined and piped to the nearest production platform. Applicants have observed that in such conventional systems, if the oil yield decreases in the recovered combined fluid, it is not possible to determine the particular well that has too much scale, and/or to determine the well to which scale inhibitor should be added. Applicants have discovered that the above problem can be significantly ameliorated or overcome by employing exemplary aspects of the present invention, for example, by introducing at least two scale inhibitors into the at least two zones or wells, respectively, wherein each of the at least two scale inhibitors corresponds to a different zone or well, and wherein the at least two scale inhibitors comprise different detectable moieties that can be distinguished by analysis. For example, this can facilitate the determination of the particular zone/well that has too much scale and/or the zone/well to which scale inhibitor should be added. By comparison, *Underdown* has no recognition of the above problem existing in conventional oilfield systems, let alone the advantages associated with employing exemplary aspects of the claimed invention.

For at least the above reasons, it is apparent that *Underdown* fails to constitute an anticipation of independent claim 23. Accordingly, withdrawal of the above §102(b) rejection is respectfully requested.

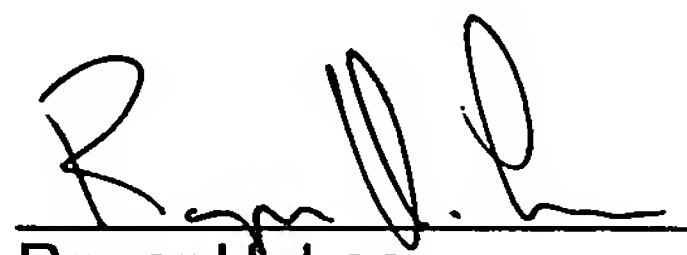
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: September 24, 2008

By:

A handwritten signature in black ink, appearing to read 'Roger H. Lee', is written over a horizontal line.

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